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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,112	04/15/2002	Michel Bercovy	15216	1559

7590

10/06/2003

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EXAMINER

MILLER, CHERYL L

ART UNIT PAPER NUMBER

3738

DATE MAILED: 10/06/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/048,112

Applicant(s)

BERCOVY, MICHEL

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. **Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.** If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "10" has been used to designate both "hollowed central part" on page 26 line

26 and “intercondylar arch” on page 24 lines 12 and 27. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “9” has been used to designate both “projecting dorsal part” on page 24 line 4 and “convex central part” on page 27 line 2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 6 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from any other multiple dependent claim (claim 4 in this case). See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 recites “the femur” in line 24 and 58, which is a portion of the body and considered non-statutory subject matter, therefore should not be positively claimed. Claims 2-5 depend upon claim 1 and inherit all problems associated with the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Referring to claim 1, lines 1 and 4, "generally of metal" is unclear. It is suggested to change "generally of metal" to recite --generally made of metal--. Also in claim 1, lines 3 and 4, applicant recites "can be implanted". It is suggested to change "can be implanted" to recite --is implantable--. Also in claim 1, lines 12 and 15, "on the one hand" and "on the other hand" is unclear. Claim 1 recites the term "it" or "it's" several times in lines 25, 26, and 27. It is unclear as to what "it" is referring to. Claim 1 also recites in lines 20, 21, and 23 "seen from the front" and "seen in profile" which are unclear limitations. It is suggested to change these limitations to --in a frontal plane-- and --in a sagittal plane-- respectively. Claim 5 line 2 recites "in a manner known per se" which is unclear. It is noted to the applicant that certain limitations (specifically the ones with designated reference numeral) are inconsistent in their terminology throughout the claims. It is suggested to the applicant to select one term or phrase and recite the exact term or phrase each time the applicant wishes to claim that particular limitation.

Claim 1 recites the limitation "the type" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the latter" in lines 11, 39, and 51. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the surface" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the intercondylar arch (10)" in line 21. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "the intercondylar arch (10)" to recite --the hollowed central part (10)--.

Claim 1 recites the limitation "the femoral component (2)" in line 29. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this limitation to --the femoral component (1)--.

Claim 1 recites the limitation "the two components" in line 31. There is insufficient antecedent basis for this limitation in the claim. It is unclear what two components the applicant is referring to the femoral component and the tibial component or the insert.

Claim 1 recites the limitation "incurved central portion (9)" in line 40. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this limitation to --projecting central part (9)-- or --the projecting central part (9) having an incurved central portion--.

Claim 1 recites the limitation "a hollowed part (8)" in line 42. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this limitation to --lateral cavities (8)-- or --the lateral cavities (8) having a hollowed portion--.

Claim 1 recites the limitation "the whole" in line 45. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "hollowed undulating central portion (9)" in line 52. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this limitation to --projecting central part (9)-- or --the projecting central part (9) having a hollowed and undulating shape--.

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Regarding claim1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 2-5 depend upon claim 1 and inherit all problems associated with the claim

Claim 2 recites the limitation "convex central projection (9)" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this limitation to --projecting central part (9)--.

Claim 2 recites the limitation "hollowed lateral parts (8)" in line 4. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this limitation to --lateral cavities (8)--.

Claim 4 recites the limitation "the femoral contact surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the contact surface" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the two surfaces" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the condylar parts and the central part (7)" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this limitation to --the condylar lateral parts (7) and the hollowed central part (10)--.

Claim 5 recites the limitation "condylar parts and central part (9)" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this limitation to --the lateral condylar cavities (8) and projecting central part (9)--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (USPN 5,330,533). Walker discloses a knee prosthesis (col.1, lines 4-5) having a metal femoral component (col.7, lines 39-40; fig.4a), a metal tibial component (col.7, line 40), and a plastic intermediate component (col.7, lines 44-45; fig.4b). Walker discloses the femoral component (fig.4a) having two lateral condylar surfaces (31) and a hollowed central part (33). Walker discloses a intermediate component (43, fig.4b) having two lateral cavities and a projecting central part (see fig.4b). Walker has shown a projecting central part of the intermediate component being convex in a frontal plane (fig.4b, 7c) and concave in a sagittal plane (fig.4b, 5b, 5c, 7b). Walker has shown the hollowed central part (33) of the femoral component being concave in a frontal plane (fig.6) and convex in a sagittal plane (fig.4a, 5b). Walker has shown no sharp edges or discontinuity on the surfaces of the components (fig.4a, 4b). Walker has shown the components having an undulating curve in the frontal plane (fig.4a, 4b, 7c) and a spiral curve in the sagittal plane (fig.4a, 4b, 5b, 5c 7b). Walker discloses the projecting central portion of the intermediate component having a constant radius (R1) from front to rear (col.1, lines 49-52, because the femoral component has a constant radius, and since the intermediate component corresponds to the femoral component, the intermediate component inherently also

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has a constant radius from front to rear). Walker discloses the hollowed central part (33) of the femoral component (fig.4a) having a constant radius (R) from front to rear (col.1, lines 36-40; col.4, lines 64-68; col.6, lines 50-54). Walker discloses the femoral component and the intermediate component surfaces having a continuous contact from extension to flexion (col.1, lines 21-23, 42-58; col.6, lines 37-38).

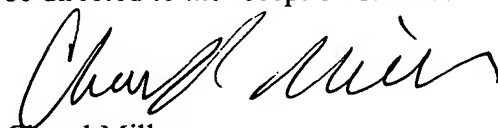
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Cheryl Miller



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